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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/476,334 | 01/03/2000 | MAKOTO SAITO | 990696A | 7676 |

23850 7590 12/31/2001

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[REDACTED] EXAMINER

HAYES, JOHN W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2161 | |

DATE MAILED: 12/31/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/476,334 | SAITO, MAKOTO |
| | Examiner John W Hayes | Art Unit 2161 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 October 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 71-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 73-78 is/are allowed.
- 6) Claim(s) 71 is/are rejected.
- 7) Claim(s) 72,79 and 80 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 October 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 08/536,747.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 71-80 in the response filed 11 October 2001. Thus, claims 71-80 are the only claims remaining in the application and are again presented for examination.

Terminal Disclaimer

2. The terminal disclaimer filed on 11 October 2001 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,069,952 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

3. Applicant's arguments with respect to claims 71-72 and 79-80 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 11 October 2001 have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury et al, U.S. Patent No. 5,509,074 in view of Butter et al, U.S. Patent No. 5,381,480.

As per claim 71, Choudhury et al disclose a method of protecting electronically published materials using cryptographic protocols and teaches a method of encrypting unencrypted data using a first secret key (Col. 2, lines 59-61; Col. 4, lines 1-26), supplying the encrypted data to a primary user and decrypting the encrypted data using the first secret key (Col. 2, lines 60-64; Col. 4, lines 1-26), displaying the decrypted data (Col. 2, lines 60-64; Col. 4, lines 1-26). Choudhury et al fail to specifically disclose re-encrypting the decrypted data using a second secret-key and storing, copying or transferring the re-encrypted data and not the decrypted data. Butter et al disclose a system for translating encrypted data and further disclose encrypting unencrypted data using a first secret key (Col. 1, lines 10-13 and 47-53; Col. 2, lines 27-31; Col. 3, lines 1-8; Col. 4, lines 10-15), decrypting the data using the first secret key (Col. 1, lines 15-20 and 59-64; Col. 2, lines 7-10 and 30-37; Col. 4, lines 19-23) and re-encrypting the decrypted data using a second secret key and transferring the re-encrypted data and not the decrypted data (Col. 1, lines 19-27; Col. 2, lines 37-53; Col. 3, lines 4-8; Col. 4, lines 27-34). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Choudhury et al et al and include the capability to re-encrypt the decrypted data with a second secret-key and then transfer the re-encrypted data as taught by Butter et al. Butter et al provides motivation by indicating that in some cases, data must be transmitted from a second site to a third site which does not have the same secret key, but a different secret key and that it is sometimes necessary to translate the data using a second secret key that the third site has access to. Thus, information could be encrypted by a first site using a first secret key, decrypted by a second site using the first secret key and further re-encrypted by the second site using the a second secret-key used by the third site.

Allowable Subject Matter

7. Claims 73-78 are allowed over the prior art of record.

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8. Claims 72 and 79-80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:
As per claims 73-78, the prior art of record when taken either individually or in combination with other prior art of record fails to teach or suggest the use of a copyright control program to carry out the recited steps of encrypting, decrypting and re-encrypting using first and second secret keys.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Klonowski discloses a method and apparatus for encrypted communication in data networks and teaches encrypting messages from an originating node to a destination node using one key and further wherein the destination node decrypts the message and then re-encrypts the message with a different key
- Hamilton et al disclose a method and apparatus for controlling access to digital signals and teach encrypting signals over a first communication path using a first encryption scheme and further decrypting

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the signals and transmitting the signals over a second communication path using a second encryption scheme.

12. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Grundy discloses a method and system for decentralized manufacture of copy-controlled software
- Halter et al disclose a method and system for securely distributing a plurality of software files from a distributor to a user
- Nagahama discloses the use of encryption techniques for licensing to use software products that are sold on a piece by piece basis
- Newell discloses a system for preventing unauthorized copying of recorded information
- Matyas et al [EP 0191162 A2] disclose a method of software protection wherein encryption keys are used so that software can be run only on designated computers or by users possessing a designated smart card.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-7239 (for formal communications intended for entry).

The Fax phone number for **AFTER-FINAL** communications where this application or proceeding is assigned in (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

John Hayes

21 December 2001



Hyung-Sub Sough
Primary Examiner